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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,388	06/08/2000	Masamichi Nakashiba	2000-0722	9958

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EXAMINER
NGUYEN, GEORGE BINH MINH

ART UNIT	PAPER NUMBER
3723	

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/589,388	Applicant(s) NAKASHIBA ET AL.	
	Examiner George Nguyen	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Applicant's response filed on 11/22/02* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17,38-56 and 68-86* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-11 and 73-86* is/are allowed.

6)☒ Claim(s) *12-17,38-56 and 68-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Receipt is acknowledged of the request for reconsideration filed on November 22, 2002.

Claims 1-17, 38-56, 68-71, 73-86 are presented for examination.

Please note that this action is final. The double patenting rejection below is needed to take the child reissue application 10/142,980 into account. Applicant is required to make a heading cross-reference to the child case in the specification of the instant application.

Reissue Applications

1. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178. Please note that the original patent was not surrendered in accordance with the offer filed on September 04, 2000.

2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-17, 38-56, 68-71, and 73-86 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is due the amendment filed on June 02, 2002.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

> "Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

3. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action. Please note that the consent of assignee to reissue and 37 CFR 3.73 (B) statement filed on Paper No. 3 was not signed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 12-13, 16-17, 38-47, 49-56, and 68-71 are rejected under 35 U.S.C. 102(a) as being anticipated by Hoshizaki et al.'530.

With reference to Figs. 10-16a-f, col. 10, line 42 to col. 14, line 20, Hoshizaki discloses the claimed invention including: a) a top ring 202 with pressurized fluid 281 being fed into a plurality of concentric chambers 310 and 312; and b) presser ring 291. Please note that in col. 13, lines 56 to col. 14, line 6, Hoshizaki discloses that each chamber has separate port and is separately pressurized or evacuated with fluid or gas to

achieve the desired contour of wafer. Thus, inherently, Hoshizaki teaches that the pressure of each chamber is independently adjusted to achieve the desired contour of wafer to precisely control the removal rate. In col. 14, lines 1-6, Hoshizaki inherently teaches that more than two (2) chambers are needed as required to obtain other contour patterns.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 14-15, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshizaki et al.'530.

Hoshizaki has been discussed above, but does not disclose an adjustable presser ring being controllably adjusted by an air actuator. Regarding to claims 14-15 and 48, Official Notice is taken that air actuator is well-known in the art to control the presser ring in the desired location to control the edge polishing of wafer. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the polishing apparatus of Hoshizaki with an air actuator to control the presser ring in the desired location to control the edge polishing of wafer.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 12-17, 38-56, and 68-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-46 of copending Application No. 10/142,980. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the copending application and covered by the copending application claims. The copending application claims are inclusive for they are drafted using the "comprising-style" format and cover the subject matter of the application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

6. Claims 1-11 and 73-86 are allowed.

Response to Arguments

7. Applicant's arguments filed November 22, 2002 have been fully considered but they are not persuasive. The examiner does not agree with Applicant's assertion that the structure of Hoshizaki et al. does not allow for providing independently adjustable

pressures in different areas of the wafer. In Fig. 16f, Hoshizaki et al. uses platen 277 preferably made of metal such as steel. However, Fig. 16f shows that platen 277 is thin enough such that platen 277 could be bended inward or outward, depending on the applied pressure, to provide a concave or convex surface. Therefore, the platen surface for chamber 310 could be concave or convex, while the platen surface for chamber 312 could be concave or convex. That is, the platen surface for chamber 310 and 312 could be in any combinations of concave and convex shape, respectively, depending on the desired contour as explicitly stated in col. 13, line 56 to col. 14, line 6. That is the platen surface of chamber 310 and chamber 312 can be independently adjusted to be concave or convex. The flexibility of the platen 277 as shown in Fig. 16f will allow the pressure applied to the wafer area to be independently adjusted. For the above reasons, applicant has failed to successfully rebut an inherency rejection applied to the product and process claims in the above rejection.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Nguyen whose telephone number is 703-308-0163. The examiner can normally be reached on Monday-Friday/630AM-300PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703-308-2687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

George Nguyen
Primary Examiner

George Nguyen
Primary Examiner
Art Unit 3723

GN
January 21, 2003